

REMARKS

Claims 1-26 are pending in the application. In response to the Office Action, applicants have amended the specification and claims 7, 9, 11, 13, 18, 20, and 22. Claims 1-26 remain pending for reconsideration.

The specification and claims are amended editorially for reasons not related to patentability. No new matter has been added.

Claims 13 and 22 were objected to because of informalities. Claims 6, 13, and 22 were objected to under 35 U.S.C. § 112 because of editorial problems. It appears that the rejection of claim 6 was intended for claim 7. Claims 7, 13, and 22 have amended to address the informalities. Claims 9 and 18 were amended editorially to provide the appropriate antecedent basis for the objection to claims 13 and 22. Applicants submit that the claims are now in proper form. Because the office action makes no substantive rejection of claims 13 and 22, Applicants consider those claims to be allowable.

Claims 1-3 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,987,538 (Tavallaei). Applicants respectfully traverse this rejection for the following reasons.

The office action sets forth the rejection based on Figure 2 of Tavallaei and a general allegation that the reference shows all of the elements recited in claim 1. In this regard, the rejection fails to comply with 37 C.F.R. § 104 (c)(2), because the office action does not sufficiently designate the particular part of the reference relied upon for disclosing each claim recitation. Even upon review of the corresponding description of Fig. 2 of Tavallaei, it is unclear as to how the reference is applied to the claim. Applicants are not required to guess as to how the reference is being applied to the claim. If the rejection is maintained, a new non-final action is respectfully requested with a sufficiently detailed explanation of the Examiner's position, so that a full and fair response may be made.

In any event, claim 1 includes numerous recitations not taught or suggested by Tavallaei. For example, the relied upon component 14 does not identically disclose the recited scaleable node controller. The relied upon component 26 does not identically disclose the recited scalability port switch. The rejection completely fails to address many of the claim recitations, particularly the interrelationships between claim recitations, and accordingly fails to establish anticipation.

Because the office fails to establish anticipation of each and every claim recitation, and because Tavallaei fails to teach or suggest the invention as recited in claim 1, claim 1 is patentable over Tavallaei. Claims 2 and 3, which depend from claim 1 are likewise patentable.

With respect to claim 3, applicants note that the office action erroneously indicates that the PCI bus is coupled between the device and the component 26, when in fact the PCI bus described in Tavallaei is coupled to the component 28.

Claims 9-12, 14-21, and 23-26 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,944,809 (Olarig). Applicants respectfully traverse this rejection for the following reasons.

The office action does not clearly explain the Examiner's position as to how the reference is being applied to the claim. The office action completely fails to even mention many of the claim recitations. Applicants do not understand how the short passages relied upon in the office action are alleged to read upon the claims. If the rejection is maintained, Applicants respectfully request a new non-final office action that sets forth a sufficiently detailed explanation of the Examiner's position, so that a full and fair response may be made.

In any event, Olarig appears to be completely silent as to a scalability port switch, a scaleable node controller, and numerous other recitations of independent claims 9 and 18. Accordingly, Olarig cannot possibly anticipate or bear on the patentability of claims 9 and 18. Claims 10-12, and 14-17 depend either directly or indirectly from claim 9 and are likewise patentable. Claims 19-21 and 23-26 depend either directly or indirectly from claim 18 and are likewise patentable.

Claims 4 and 5 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Tavallaei in view of U.S. Patent No. 6,119,191 (Neal). Claims 6 and 7 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Tavallaei, in view of Neal, and further in view of Olarig. Claim 8 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Tavallaei, in view of Neal, further in view of Olarig, and further in view of U.S. Patent No. 6,606,676 (Deshpande). Applicants respectfully traverse this rejection for the following reasons.

None of the secondary references make up for the missing teachings of Tavallaei noted above. For example, none of the cited references even mentions a scalability port switch. Therefore, the office action fails to establish a prima facie case of obviousness.

Moreover, the office action fails to provide legally sufficient motivation to combine or modify the references in the manner suggested. The office action appears to use the claims as a blueprint to pick and choose pieces of prior art which allegedly read on various claim recitations without identifying any portion of the references which actually suggests the desirability of any of the proposed modifications. In particular, no one skilled in the art would be motivated to combine the multiplicity of references as applied in the rejection of claims 6-8, absent the teachings of the present application.

Because the secondary references fail to make up for the deficiencies in Tavallaei, and because there is no motivation to combine the references as suggested by the office action, claims 4-8 are patentable over the cited references.

In view of the foregoing, favorable reconsideration and withdrawal of the rejections is respectfully requested. Early notification of the same is earnestly solicited. If there are any questions regarding the present application, the Examiner is invited to contact the undersigned attorney at the telephone number listed below.

Respectfully submitted,

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